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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,710	07/15/2002	Graeme Deaker	TJK/216	3993
27717	7590	10/31/2005		
SEYFARTH SHAW LLP 55 EAST MONROE STREET SUITE 4200 CHICAGO, IL 60603-5803			EXAMINER CANGIALOSI, SALVATORE A	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/069,710

**Applicant(s)**

DEAKER ET AL.

**Examiner**

Salvatore Cangialosi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/27/02</u> . | 6) <input type="checkbox"/> Other: _____  |

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1. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

2. Claims 1-40 are rejected under 35 U.S.C. § 103 as being unpatentable over Fortenberry et al (WO 99/30256) in view of any of Manasse (WO 97/03423 (both cited by applicant), Scroggie et al (6014634) or Jacoves et al (6741968).

Regarding claim 1, Fortenberry et al (See abstract, Figs. 1-4, pages 2,3, page 5, lines 1-40 claims 1-15) disclose method for issuing an electronic coupon recorded in a database and subsequently compared with it upon redemption for goods or services substantially as claimed. The differences between the above and the claimed invention is the use of specific terms token and voucher. It is noted that it is believed that coupons are functionally equivalent to a token/voucher. Each of Manasse (see abstract, Figs. 3-5, pages

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2-3, page 11, lines 15-20, claims 1-12), Scroggie et al (See abstract, Figs. 1,5, 10-13,15-18) or Jacoves et al (See abstract, Figs. 2,8, 10, 25) show network distributed tokens or vouchers for goods or services. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Fortenberry et al because the coupon incentives are conventional functional equivalents with respect to the claim limitations and electronic network distribution is standard delivery for any digital content. Regarding the network limitations of claim 2, Fortenberry et al (See abstract, Figs. 1-4, pages 2,3, page 5, lines 1-40 claims 1-15) disclose issuing an electronic coupon recorded in a database over a network and subsequently compared with same upon redemption for goods or services which is a functional equivalent of the claim limitations. Regarding the delivery limitations of claim 3, Fortenberry et al (See abstract, Figs. 1-4, pages 2,3, page 5, lines 1-40 claims 1-15) disclose issuing an electronic coupon recorded in a database over a network and subsequently compared with same upon redemption for goods or services which is a functional equivalent of the claim limitations. Regarding the order limitations of claim 4, Manasse (see abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12), Scroggie et al (See abstract, Figs. 1,5, 10-13,15-18) or Jacoves et al (See abstract, Figs. 2,8, 10, 25) show network distributed tokens or vouchers for goods or services including web linked processing

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which is a functional equivalent of the claim limitations. Regarding the order limitations of claims 5, Manasse (see abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12), Scroggie et al (See abstract, Figs. 1,5, 10-13,15-18) or Jacoves et al (See abstract, Figs. 2,8, 10, 25) show network distributed tokens or vouchers for goods or services including web linked processing which is a functional equivalent of the claim limitations. Regarding the web limitations of claims 6, Manasse (see abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12), Scroggie et al (See abstract, Figs. 1,5, 10-13,15-18) or Jacoves et al (See abstract, Figs. 2,8, 10, 25) show network distributed tokens or vouchers for goods or services including web linked processing which is a functional equivalent of the claim limitations. Regarding the web limitations of claims 7, Manasse (see abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12), Scroggie et al (See abstract, Figs. 1,5, 10-13,15-18) or Jacoves et al (See abstract, Figs. 2,8, 10, 25) show network distributed tokens or vouchers for goods or services including web linked processing which is a functional equivalent of the claim limitations. Regarding the web limitations of claim 8, Manasse (see abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12), Scroggie et al (See abstract, Figs. 1,5, 10-13,15-18) or Jacoves et al (See abstract, Figs. 2,8, 10, 25) show network distributed tokens or vouchers for goods or services including web linked processing which is a

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functional equivalent of the claim limitations. Regarding the user limitations of claim 9, Fortenberry et al (See abstract, Figs. 1-4, pages 2,3, page 5, lines 1-40 claims 1-15) disclose issuing an electronic coupon recorded in a database over a network and subsequently compared with same upon redemption for goods or services which is a functional equivalent of the claim limitations. Regarding the network limitations of claim 10, Manasse (see abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12), Scroggie et al (See abstract, Figs. 1,5, 10-13,15-18) or Jacoves et al (See abstract, Figs. 2,8, 10, 25) show network distributed tokens or vouchers for goods or services including web linked processing which is a functional equivalent of the claim limitations. Regarding the beneficiary limitations of claim 11, Manasse (see abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12), Scroggie et al (See abstract, Figs. 1,5, 10-13,15-18) or Jacoves et al (See abstract, Figs. 2,8, 10, 25) show network distributed tokens or vouchers for goods or services including web linked processing which is a functional equivalent of the claim limitations because manufacturers distribute coupons electronically to a plurality of customers. Regarding the redemption limitations of claims 12-20, Manasse (see abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12), Scroggie et al (See abstract, Figs. 1,5, 10-13,15-18) or Jacoves et al (See abstract, Figs. 2,8, 10, 25) show network distributed tokens or vouchers for goods or services

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including web linked processing which is a functional equivalent of the claim limitations. Regarding the processing limitations of claims 21-24, Manasse (see abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12), Scroggie et al (See abstract, Figs. 1,5, 10-13,15-18) or Jacoves et al (See abstract, Figs. 2,8, 10, 25) show network distributed tokens or vouchers for goods or services including web linked processing which is a functional equivalent of the claim limitations because these are no more than the standard processing of coupons. Regarding the image limitations of claims 25-28, Scroggie et al (See abstract, Figs. 1,5, 10-13,15-18) show network distributed tokens or vouchers for goods or services including web linked processing including image(See Fig. 11) which is a functional equivalent of the claim limitations because these are no more than the standard processing of coupons. Regarding the delivery limitations of claims 29-33, Manasse (see abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12), Scroggie et al (See abstract, Figs. 1,5, 10-13,15-18) or Jacoves et al (See abstract, Figs. 2,8, 10, 25) show network distributed tokens or vouchers for goods or services including web linked processing and email which is a functional equivalent of the claim limitations. Regarding claim 34, Fortenberry et al (See abstract, Figs. 1-4, pages 2,3, page 5, lines 1-40 claims 1-15) disclose a means for issuing an electronic coupon recorded in a database and subsequently compared with it upon redemption for goods or

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services substantially as claimed. The differences between the above and the claimed invention is the use of specific terms token and voucher. It is noted that it is believed that coupons are functionally equivalent to a token/voucher. Each of Manasse (see abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12), Scroggie et al (See abstract, Figs. 1,5, 10-13,15-18) or Jacoves et al (See abstract, Figs. 2,8, 10, 25) show network distributed tokens or vouchers for goods or services. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Fortenberry et al because the coupon incentives are conventional functional equivalents with respect to the claim limitations and electronic network distribution is standard delivery for any digital content.

Regarding claim 35, Fortenberry et al (See abstract, Figs. 1-4, pages 2,3, page 5, lines 1-40 claims 1-15) disclose a means for issuing an electronic coupon recorded in a database and subsequently compared with it upon redemption for goods or services substantially as claimed. The differences between the above and the claimed invention is the use of specific terms token and voucher. It is noted that it is believed that coupons are functionally equivalent to a token/voucher. Each of Manasse (see abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12), Scroggie et al (See abstract, Figs. 1,5, 10-13,15-18) or Jacoves et al (See abstract, Figs. 2,8, 10, 25) show network distributed tokens or vouchers for goods or services. It would



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have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Fortenberry et al because the coupon incentives are conventional functional equivalents with respect to the claim limitations and electronic network distribution is standard delivery for any digital content.

Regarding the bank limitations of claims 36-39, Manasse (see abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12) show network distributed tokens or vouchers for goods or services including web linked processing in an electronic bank equivalent which is a functional equivalent of the claim limitations. Regarding claim 40, Fortenberry et al (See abstract, Figs. 1-4, pages 2,3, page 5, lines 1-40 claims 1-15) disclose a means for issuing an electronic coupon recorded in a database and subsequently compared with it upon redemption for goods or services substantially as claimed. The differences between the above and the claimed invention is the use of specific terms token and voucher. It is noted that it is believed that coupons are functionally equivalent to a token/voucher. Each of Manasse (see abstract, Figs. 3-5, pages 2-3, page 11, lines 15-20, claims 1-12), Scroggie et al (See abstract, Figs. 1,5, 10-13,15-18) or Jacoves et al (See abstract, Figs. 2,8, 10, 25) show network distributed tokens or vouchers for goods or services. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Fortenberry et al because the coupon incentives

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are conventional functional equivalents with respect to the claim limitations and electronic network distribution is standard delivery for any digital content.

**Examiner's Note:** Although Examiner has cited particular columns, line numbers and figures, in the references as applied to the claims above for the convenience of the applicant(s), the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual claim and other passages and figures may apply as well. It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication should be directed to Salvatore Cangialosi at telephone number **(571) 272-6927**. The examiner can normally be reached 6:30 Am to 5:00 PM, Tuesday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached at **(571) 272-6712**.

**Any response to this action should be mailed to:**

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ART UNIT 222